

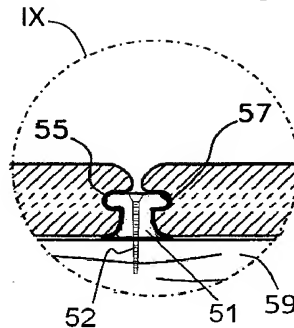
REMARKS

The present Amendment is responsive to the Official Actions mailed on July 9, 2010 and August 30, 2010, and is timely filed within the three-month shortened statutory period for filing a response. Claims 29-34 and 36-38 were pending at the time of the Action. Claims 29-32 stand withdrawn from consideration. Claim 38 has been canceled. Claims 33, 34, and 36 have been amended, and new claims 39-43 have been added. No new matter has been added. In view of the amendments and remarks made herein, reconsideration of the Examiner's rejections and Notice of Allowance of all pending claims is earnestly solicited.

In the Official Action, the Examiner did not accept the drawings submitted on December 17, 2009. The Examiner averred that the applicant "failed to point out where the fastener's tapered flush mounted head, tapered shank, specific length, diameter, threading, etc. were originally presented in the application as filed." (Official Action 3.) According to the Examiner, the new drawings contain new matter. Applicant respectfully disagrees.

"[I]nformation contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter." M.P.E.P. § 2163.06. "What is conventional or well known to one of ordinary skill in the art need not be disclosed in detail. . . . If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met." M.P.E.P. § 2163 (citations omitted.) "The description need only describe in detail that which is new or not conventional." *Id.*

Fig. 9



In the previous Amendment, Applicant merely amended the drawings to include the subject matter described in the present application as filed. As seen in Figure 9 of the present application, which has been reproduced above, the anchoring device is capable of having a metal fastener 52 driven therethrough. The present application, as filed, states that the anchoring device may be "capable of having a metal fastener driven through." (Present Application 24.) In addition, the present application, as originally filed, states that "[a] staple, nail or screw is passed through anchoring device 1 into joist beam 59." (*Id.* 32.)

Figure 9 merely shows a conventional metal fastener 52 driven through the anchoring device. Since Figure 9 is not drawn to scale, it does not convey any specific information about the dimensions of the fastener 52. Thus, Figure 9 does not convey information about the specific length and diameter of fastener 52. See M.P.E.P. § 2125 ("Proportions of features in a drawing are not evidence of actual proportions when drawings are not to scale.") Accordingly, Applicant respectfully submits that Figure 9 does not introduce new matter relating to the specific length and diameter of fastener 52.

The Examiner also contended that the tapered flush mounted head, tapered shank, and threading of fastener 52, as shown in Figure 9, constitute new matter. Applicant respectfully disagrees. As stated above, conventional or well

known features or devices need not be disclosed in detail. The description need only describe in detail that which is new or not conventional. The alleged tapered flush mounted head, tapered shank, and threading of the fastener illustrated in Figure 9 are all conventional or well known features of typical fasteners. As such, Applicant does not need to describe in detail conventional features of well known fastener 52. If the Examiner believes that any feature of the fastener shown in Figure 9 is novel or not conventional, Applicant respectfully requests the Examiner to specify such novel or not conventional features. Absent a showing that the features of the fastener 52 shown in Figure 9 are novel or not conventional, it is reasonable to conclude that fastener 52 merely discloses a conventional fastener. Accordingly, Applicant respectfully submits that the fastener shown in Figure 9 does not constitute new matter.

For the foregoing reasons, Applicant respectfully submits that the previous amendments to the drawings did not introduce new matter. Applicant also submits that the drawings comply with 37 C.F.R. § 1.83(a) because they show all the features recited in the claims.

In addition to the objection to the drawings, the Examiner rejected claims 33, 34 and 36-38 under 35 U.S.C. § 112, second paragraph, as being indefinite. Without acquiescing to the rejection set forth in the Official Action and in the interest of advancing prosecution, the pending claims have been amended to address the Examiner's concerns, as follows:

- The language regarding the "metal fastener" in claim 33 has been clarified.
- The phrase "being measured a" in claim 33 has been amended to recite "being measured at a".

- The possessive pronoun "its" has been deleted from claim 33.
- Claim 33 has been amended to eliminate double inclusions. Specifically, claim 33 has been amended for the sake of clarity, as follows:
 - o Claim 33 now recites an anchoring device; all other references to "anchoring device" are preceded by a definite article "the" or the term "said."
 - o Amended claim 33 now recites "two adjacent decking boards" instead of "two adjacent boards."
 - o The term "receiving slots" has been deleted from claim 33.
- The term "said grooves" in claim 33 has been replaced with the term "the at least one groove."
- The term "each said board" in claim 36 has been deleted.
- Claim 36 has been amended to clarify the structural relationships recited therein.
- Claim 38 has been canceled.

In the Official Action, the Examiner set forth the following rejections under 35 U.S.C. § 103(a):

- Claims 33, 37, and 38 over U.S. Patent Publication No. 2002/0121064 to Erwin ("Erwin") in view of U.S. Patent No. 2,115,270 to Leash ("Leash") and U.S. Patent No. 4,449,346 to Tremblay ("Tremblay");
- Claim 34 over Erwin in view of Leash, Tremblay and U.S. Patent No. 4,154,172 to Curtis Jr. ("Curtis"); and
- Claim 36 over Erwin, Leash, Tremblay and U.S. Patent No. 239,846 to Ring ("Ring").

As seen above, each of the rejections is primarily based on a combination of Erwin and Leash. However, the proposed combination of Erwin and Leash is improper. Therefore, Applicant respectfully submits that claim 33, which is the only rejected independent claim, is patentable over Erwin in view of Leash and Tremblay. Likewise, the dependent claims are believed to be allowable. For ease of discussion, the following remarks begin with claim 33 only.

Claim 33 recites a decking system including, *inter alia*, a plurality of decking boards and an anchoring device comprising a substantially flat horizontal top element, at least one substantially vertical support member, and a substantially flat horizontal bottom element having a generally trapezoidal shape.

In supporting the rejection of claim 33, the Examiner alleged that Erwin includes all of the features with the exception of a trapezoidal base. However, the Examiner contended that Leash teaches a trapezoidal shape element in Figure 2, and such shape could be used with the Erwin device. Providing Erwin with the trapezoidal portion of Leash would render Erwin inoperable for its intended purpose and change its principle of operation. See M.P.E.P. § 2143.01.

M.P.E.P. § 2143.01 states that "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." *Id.*

Leash relates to a batten for vertical sheathing or siding. As seen in Figure 2 of Leash, the trapezoidal portion

of this batten extends through the entire height of the siding boards. There is no teaching in Leash to suggest that the trapezoidal base can be configured any other way. Thus, providing Erwin's clip with the trapezoidal portion of Leash would result in a clip with arms 26 positioned on top of wood core 12 rather than within grooves 22. As shown in Figure 1 of Erwin, clip 24 is T-shaped and has arms 26 sized to fit within grooves 22 of adjacent planks to connect such planks. If the trapezoidal portion of Leash is added to the clip 24 of Erwin, the clip 24 would not be able to connect the adjacent planks, as intended by Erwin, because the arms 26 would not be positioned inside the grooves 22. Accordingly, the proposed combination of Erwin and Leash would render Erwin inoperable for its intended purpose and would change the principle of its operation. As discussed above, combinations that would render the primary reference inoperable for its intended purpose and change the principle of its operation are improper.

Tremblay also fails to cure the deficiencies of Erwin and Leash. In particular, Tremblay relates to a panel assembly including a connector member 14. According to the Official Action, the connector member 14 of Tremblay includes "a trapezoidal shaped bottom element having a width less than the top element." (Official Action 8.) The Examiner nevertheless fails to show how Tremblay discloses or suggests a bottom element with a maximum width greater than the maximum width of a vertical support member. In this regard, Tremblay fails to disclose or suggest an anchoring device, wherein the maximum width of the horizontal bottom element is greater than the maximum width of the vertical support member. The dimensional relationships recited in claim 33 are not obvious design choices. Instead, such dimensional relationships provide the anchoring device of the present application with significant

advantages over the prior art. In this regard, the present application states:

FIG. 4 shows a blown up end view of anchoring device 1 as shown in FIG. 3, with identical parts identically numbered in part, and with width designations, as illustrated. Specifically, in FIG. 4, top element 2 has a width W_{TB} , as measured from side to side at its maximum width. Vertical support member 4 has width W_M , as measured from side to side at its maximum width. Likewise, bottom element 6 has a width W_B , as measured from side to side at its maximum width. It is important to note that W_T , the first predetermined width, being the width of top element 2, is greater than both W_M , the predetermined width of vertical support member 4, as well as W_B , the predetermined width, being a third predetermined width of bottom element 6. In other words, the width of the top element is greater than both the width of the vertical support member and the width of the bottom element. Moreover, the width of bottom element 6, W_B , while it is less than width W_T of top element 2, it is also greater than the width of vertical support member 4, W_B . **These critical relationships allow for maximum support of adjoining slotted boards while minimizing the space between the boards to typical or conventional deck spacing.** (Present Application 29-30 (emphasis added).)

In view of the foregoing, Applicant respectfully submits that Erwin, either alone or in combination with Leash, Tremblay or any other reference of record, fails to disclose or suggest an anchoring device including a top element having a first predetermined width, at least one vertical support member having a second predetermined width, and a bottom element having a third predetermined width, "wherein said first predetermined width is greater than both said second predetermined width and third predetermined width, and wherein said third predetermined width is greater than said second predetermined width," in

combination with a trapezoidal base as recited in amended claim 33. For at least the foregoing reasons, Applicant respectfully submits that claim 33 is patentable over the references of record.

With respect to claim 34, the Examiner acknowledged that Erwin fails to disclose a vertical support member having recesses with support columns but asserted that Curtis discloses "a support column 17, 21 having recesses (the openings) to allow the insertion of a fastener therethrough." (Official Action 11.) The Examiner added that it would have been obvious to add the aperture of Curtis to the vertical support of Erwin. According to the Examiner, "[g]iven the modification, support columns would have been located between the recesses in general." *Id.* Applicant respectfully disagrees.

Curtis relates to a deck 11 including a plurality of fastening members 17. Each fastening member 17 includes a body portion 21. "The body portion 21 of each of the fastening members 17 preferably includes an aperture 29 therethrough." (Curtis col.2 ll.30-32.) "Means such as a nail 45 or the like is then passed through the aperture 29 in the body portion 21 of the fastening member 17' and into the first plank 19' to fixedly attach the fastening member 17' and the first plan member 19' together." (Curtis col.2 l.68 - col.3, l.4.)

Applicant respectfully submits that Curtis does not include a plurality of recesses (*i.e.*, indentations) disposed on each of the two sides of the vertical support member, as recited in amended claim 34. Rather, Curtis merely discloses an aperture 29 (*i.e.*, a hole) for receiving a nail 45. Aperture 29 extends through the entire width of the body portion 21 of the fastening member 17. Accordingly, fastening member 17 does not include recesses on each of the two sides of a vertical support member. Moreover, the aperture of Curtis does not create support columns disposed along at least one of the two sides of

the vertical support member, as recited in amended claim 34. Indeed, modifying the clip of Erwin to include the aperture of Curtis would not create support columns at all. Such modification would only render a clip with a hole dimensioned to receive a nail and extending along the entire width of the clip. For at least the foregoing reasons, Applicant respectfully submits that Erwin, alone or in combination with Curtis or any other cited art, fails to disclose or suggest the decking system recited in amended claim 34.

For at least the foregoing reasons, Applicant respectfully submits that claims 33 and 34 are patentable over the references of record. As each of the claims 36-38 depends from claim 33, it is therefore firmly believed that each of these claims is in a condition for allowance. It is also noted that although Applicant has not separately argued independent allowability of certain features of the dependent claims, such claims are believed to include patentable subject matter beyond that found in the independent claim.

As discussed above, Applicant added new claims 39-43. Claims 39 and 40 are independent claims. Applicant respectfully submits that these new claims are patentable over the references of record.

None of the references of record discloses or suggests a decking system comprising a first and second deck boards each "defining a central axis extending along a width thereof, the central axis being positioned at about a midpoint of a height of each deck board, the central axis dividing the top portion and the bottom portion of each of the first and second deck boards, the groove of each of the first and second deck boards being positioned along the central axis, the top portion of each of the first and second deck boards having a greater width than the bottom portion," as recited in new claim 39.

Accordingly, Applicant respectfully submits that claim 39 is patentable over the cited art.

The references of record also fail to disclose or suggest a decking system comprising an anchoring device including, *inter alia*, a support member and "a plurality of recesses disposed along each of the two sides of the support member," as recited in new claim 40. Hence, Applicant respectfully submits that claim 40 is patentable over the cited art. Since claims 41-43 depend from independent claim 40, it is therefore submitted that claims 41-43 are also patentable over the references of record, notwithstanding that such claims are also believed to include additional patentable subject matter.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: October 12, 2010

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